

REMARKS/ARGUMENT

1) Claim 20-46 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Application No. 08/419,229. Applicants traversed this rejection in the Office Action dated October 15, 2004 and once again traverse this rejection as set forth below.

Applicants respectfully submit that the Examiner has not established a prima facie case of obviousness-type double patenting for Claims 20-46. In order to establish a prima facie case of obviousness-type double patenting, **the Examiner must establish that the claims of the present application are obvious over the CLAIMS of U.S. Application No. 08/419,229** – NOT the teaching of the referenced application's specification, as determined by the Examiner and NOT a general allegation that all of the claims of the present application are obvious over the claims of U.S. Application No. 08/419,229. Applicants again direct the Examiner's attention to MPEP § 804(B)(1):

In determining whether a nonstatutory basis exists for a double patenting rejection, the first question to be asked is – **does any claim in the application define an invention that is merely an obvious variation of an invention claimed in the patent?** If the answer is yes, then an “obvious-type” nonstatutory double patent rejection may be appropriate.

- (A) Determine the scope and content of a patent claim and the prior art relative to a claim in the application at issue;**
- (B) Determine the differences between the scope and content of the patent claim and the prior art as determined in (A) and the claim in the application at issue;**
- (C) Determine the level of ordinary skill in the pertinent art; and**
- (D) Evaluate any objective indicia of nonobviousness.**

The conclusion of obvious-type double patenting is made in light of these factual determinations.

Any obvious-type double patent rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.

When considering whether the invention defined in a claim of an application is an obvious variation of the invention defined in the claim of a patent, **the disclosure of the patent may not be used as prior art**. This does not mean that one is precluded from all use of the patent disclosure.

In light of the above, it is clear that the Examiner has not addressed “at least” required elements (A) & (B) of MPEP § 804(B)(1). As such, the Examiner has not set forth a *prima facie* case that Claims 20-46 of the present application are obvious over the claims of U.S. Application 08/419,229. The rejection is improper and should be withdrawn.

2) Claims 20, 21, 24-28, 35 and 36 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Stefanopoulos et al., (5,333,237), in view of Schmandt et al., (“Augmenting a Window System with Speech input”, Computer Magazine 8/90, vol. 23, Issue 8, pages 50-56, and in view of Houser et al. Applicants respectfully traverse this rejection, as set forth below.

Independent Claim 20 requires and positively recites, an apparatus, comprising: “a speech user agent **that dynamically creates vocabulary, grammar and actions**” and “a browsing module for the world wide web being responsive to said speech user agent, said speech user agent facilitating voice activation of said browsing module to access an information resource on the world wide web”.

Independent Claim 35 requires and positively recites, an apparatus, comprising: “a speech user agent for accessing a browsing module for the world wide web, said speech user agent **dynamically creates vocabulary, grammar and actions to enable said browsing module to access an information resource on the world wide web**”.

Independent Claim 36 requires and positively recites, a method, comprising: “**embedding voice activated control information in HTML pages as delivered on the World Wide Web, wherein said voice control information is encoded in a grammar language and is interpreted by a Web client user-agent that translates user utterances into client actions**”.

Applicants respectfully point out that the Examiner has not complied with relevant law in setting forth her rejection of Claims 20, 35 and 36. More specifically, “all words in a claim must be considered in judging the patentability of that claim against the prior art.” In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). The Examiner has NOT addressed any of the above high-lighted terms of Claims 20, 35 or 36 in her rejection. As such, the rejection of Claims 20, 21, 24-28, 35 and 36 under 35 U.S.C. 103(a) is improper and should be withdrawn.

Even if the Examiner had addressed all of the words of each of Claims 20, 35 and 36, the Examiner has not set forth a *prima facie* case of obviousness of Claims 20, 35 and 36. In proceedings before the Patent and Trademark Office, “**the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art**”. In re Fritch, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (citing In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). “**The Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references**”, In re Fritch, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992)(citing In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988)(citing In re Lalu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)).

Independent Claim 20 requires and positively recites, an apparatus, comprising: “**a speech user agent that dynamically creates vocabulary, grammar and actions**” and “**a browsing module for the world wide web being responsive to said speech user agent, said speech user agent facilitating voice activation of said browsing module to access an information resource on the world wide web**”.

Independent Claim 35 requires and positively recites, an apparatus, comprising: “a speech user agent for accessing a browsing module for the world wide web, said speech user agent **dynamically creates vocabulary, grammar and actions to enable said browsing module to access an information resource on the world wide web**”.

Independent Claim 36 requires and positively recites, a method, comprising: “**embedding voice activated control information in HTML pages as delivered on the World Wide Web, wherein said voice control information is encoded in a grammar language and is interpreted by a Web client user-agent that translates user utterances into client actions**”.

In contrast, Stefanopoulos, Schmandt and Houser all fail to teach or suggest, “a speech user agent **that dynamically creates vocabulary, grammar and actions**”, as required by Claim 20, or “a speech user agent for accessing a browsing module for the world wide web, said speech user agent **dynamically creates vocabulary, grammar and actions to enable said browsing module to access an information resource on the world wide web**”, as required by Claim 35, as amended. Similarly, Stefanopoulos, Schmandt and Hosur all fail to teach or suggest, “**embedding voice activated control information in HTML pages as delivered on the World Wide Web, wherein said voice control information is encoded in a grammar language and is interpreted by a Web client user-agent that translates user utterances into client actions**”, as required by Claim 36.

More particularly, the combination fails to obviate the inventions of Claims 20, 35 and 36 for the following reasons:

The Examiner admits that Stefanopoulos et al, does not teach a speech user agent. The Examiner instead relies upon Schmandt for such teaching. The Examiner's determination to combine Stefanopoulos and Schmandt is flawed for several reasons. First, while Schmandt discloses speech or voice to navigate in a windows environment, there is no evidence in the record that supports a determination that Schmandt's speech or voice is equivalent to Appellants'

"speech user agent". Seeming to confirm the above, the Examiner even fails to make any specific argument that Schmandt's speech or voice is equivalent to Appellants' "speech user agent". Second, even were Schmandt to disclose a "speech user agent", it fails to teach or suggest, "**a speech user agent that dynamically creates vocabulary, grammar and actions**", as required by Claim 20, as amended, or "**a speech user agent for accessing a browsing module for the world wide web, said speech user agent dynamically creates vocabulary, grammar and actions to enable said browsing module to access an information resource on the world wide web**", as required by Claim 35, as amended. Similarly, Stefanopoulos, Schmandt and Hosur all fail to teach or suggest, "**embedding voice activated control information in HTML pages as delivered on the World Wide Web**, wherein said voice control information is **encoded in a grammar language and is interpreted by a Web client user-agent that translates user utterances into client actions**", as required by Claim 36 .

Applicants further submit that the Examiner's motivation to combine Stefanopoulos and Schmandt is fatally flawed for up to four reasons. First, Schmandt's "use of speech or voice to navigate in a windows environment" is not designed for use on the "Web" - it was designed to navigate a windows environment on an X windows server. Second, such access would not be "easy" since all of the locations would have to have been pre-identified and entered into a computer by the user implementing Schmandt's computer and voice templates would have to have been previously enrolled for the specific location(s) - which is not "easy". Third, Schmandt's "use of speech or voice to navigate in a windows environment" does NOT reduce manual, intervention [i.e., the use of keyboard], as previously suggested by the Examiner. Fourth, there is no teaching or suggestion in Schmandt that would lead one of ordinary skill in the art at the time of the invention to make the determination that Schmandt's speech interface is "user friendly".

The Examiner relies upon Houser to overcome the deficiencies of the combination of Stefanopoulos et al. and Schmandt. More specifically, the Examiner determined that "Houser et al., while not teaching a browser, provides access to the Internet or the World Wide Web using speech for facilitating access to the information resources available on the World Wide Web (Col. 11, lines

47-50)" (Office Action dated September 25, 2003, page 6, line 18 – page 7, line 2). Applicants have previously described the deficiencies of the Hosur reference. More particularly, the Houser reference discloses: "**a system for controlling a device such as a television AND for controlling access to broadcast information such as video, audio, and/or text information ... in which ... a processor executes a speech algorithm using the received vocabulary data to recognize the utterances of the speaker AND for controlling the device AND the access to the broadcast information in accordance with the recognized utterances of the speaker**", (Abstract, lines 1-3 and 6-11).

Further, Houser states in its Summary of the Invention, "the present invention adds a speech recognition interface to a subscriber terminal unit in an information system for implementing spoken control of electronic devices at subscriber location and of ACCESS to information transmitted to the subscriber terminal unit" (col. 2, lines 19-23). Accordingly, Houser is concerned with ACCESSING information already transmitted to the subscriber unit but perhaps inaccessible because it is scrambled or encoded in some manner. Applicants further point out that "broadcast information" is a one-way transmission from one location to MANY receiving stations – NOT transmission from one information resource on the World Wide Web to one receiving station as in the present invention. Indeed, Houser seems to be concerned with subscription television systems, including cable television systems, so-called near video-on-demand services in which information is "broadcast" to all the stations but is not "accessible" to stations not enabled to access the selected "broadcast" information. The Communications Standard Dictionary defines the term "broadcast", 1989, as being:

The transmission method whereby **any number of organization, unit, ship, aircraft, or other stations may receive messages transmitted from a designated station**. Transmission is usually in the form of radio, television, or radiotelephone signals (see copy enclosed).

The Communications Standard Dictionary defines the term "broadcast-communication method", 1989, as being:

1. A method of transmitting messages or information to a number of receiving stations that make no receipt. 2. A method of communication in which a message is broadcast and the address does not furnish a receipt. This allows the receiver to maintain radio silence. It is used by shore stations to transmit messages to ships at sea, to aircraft in flight or to units in the field (see copy previously enclosed with amendment of February 27, 2004).

Accordingly, Houser's teaching of accessing "broadcast information", is not relevant to the present invention.

Applicants acknowledge that Houser states: "information request processor 156 may also access a communication network 158 in order to provide subscriber access to services such as the Internet" (col. 11, lines 47-50). Houser does not, however, disclose how or through what means processor 156 is capable of accessing communication network 158 in the event it is the Internet. Any combination of Houser with Stefanopoulos and Schmandt fails to teach or suggest, "a speech user agent that dynamically creates vocabulary, grammar and actions", as required by Claim 20, as amended, or "a speech user agent for accessing a browsing module for the world wide web, said speech user agent dynamically creates vocabulary, grammar and actions to enable said browsing module to access an information resource on the world wide web", as required by Claim 35, as amended. Similarly, Stefanopoulos, Schmandt and Houser all fail to teach or suggest, "embedding voice activated control information in HTML pages as delivered on the World Wide Web, wherein said voice control information is encoded in a grammar language and is interpreted by a Web client user-agent that translates user utterances into client actions", as required by Claim 36. Should the Examiner disagree, Applicants respectfully request that the Examiner specifically point out the high-lighted elements above in the Stefanopoulos, Schmandt and/or Hosur references. Barring the Examiner submitting evidence of the above-identified claim elements in the cited references, the 35 U.S.C. 103(a) rejection of Claims 20, 35 and 36 is overcome.

While Applicants have shown that the cited references, alone or in combination, do not disclose all of the elements required by Claims 20, 35 and 36, even if, arguendo, all of the claim limitations of the claims were to be present when all of the references are combined, "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, **absent some teaching or suggestion supporting the combination.** Under section 103, **teachings of references can be combined ONLY if there is some suggestion or incentive to do so.**" ACS Hosp. Systems, Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. **The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.** In re Gordon, 733 F.2d at 902, 221 USPQ at 1127. Moreover, it is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed.Cir.1991). See also Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed.Cir.1985). The Examiner's rejection does not comply with the requirements of the above case law and should be withdrawn.

Claims 21 and 24-28 stand allowable as depending from allowable claims and including further limitations not taught or suggested by the references of record.

Claim 21 further defines the apparatus of Claim 20, wherein said access of said information resource is accomplished in part through use of a grammar embedded in said information resource. Stefanopoulos, Schmandt, and/or Hosur all fail to teach or suggest the use of a grammar to embedded in an information resource. Accordingly the combination of references fails to teach this further limitation in combination with the other requirements of Claim 20.

Claim 24 further defines the apparatus of Claim 21, wherein said information resource is an HTML page. Stefanopoulos, Schmandt, and/or Hosur all fail to teach or suggest wherein said information resource is an HTML page. Accordingly the combination of references fails to teach this further limitation in combination with the other requirements of Claim 21.

Claim 25 further defines the apparatus of Claim 20, further including an instructional module for communicating allowed actions by a user. Stefanopoulos, Schmandt, and/or Hosur all fail to teach or suggest an instructional module for communicating allowed actions by a user. Accordingly the combination of references fails to teach this further limitation in combination with the other requirements of Claim 20.

Claim 26 further defines the apparatus of Claim 21, wherein said embedded grammar is a smart page grammar. Stefanopoulos, Schmandt, and/or Hosur all fail to teach or suggest smart pages or wherein said embedded grammar is a smart page grammar. Accordingly the combination of references fails to teach this further limitation in combination with the other requirements of Claim 21.

Claim 27 further defines the apparatus of Claim 21, wherein said embedded grammar is a reference to a grammar located in said information resource. Stefanopoulos, Schmandt, and/or Hosur all fail to teach or suggest embedded grammars or that such grammars can be a reference to a grammar located in said information resource. Accordingly the combination of references fails to teach this further limitation in combination with the other requirements of Claim 21.

Claim 28 further defines the apparatus of Claim 21, wherein said grammar is dynamically added to a speech recognizer. Stefanopoulos, Schmandt, and/or Hosur all fail to teach or suggest any mechanism for “dynamically” adding grammars to a speech recognizer. Accordingly the combination of references fails to teach this further limitation in combination with the other requirements of Claim 21.

3) Claims 30-34 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Stefanopoulos et al., (5,333,237), in view of Schmandt et al., ("Augmenting a Window System with Speech input", Computer Magazine 8/90, vol. 23, Issue 8, pages 50-56, and further in view of Arons ("Hyperspeech: navigating in a speech-only hypermedia", Proceedings of the third annual ACM conference on Hypertext, December 15-18, 1991, pages 133-146). Applicants again traverse this rejection, as set forth below.

Claim 30 further defines the apparatus of Claim 20, further including a means for extracting a grammar from a hypermedia source on said information resource for future reference to said source.

Claim 31 further defines the apparatus of Claim 31, further including a means for automatically producing an intelligent grammar from said information resource.

Claim 32 further defines the apparatus of Claim 32, further including a means for processing said grammar to produce a reference to said hypermedia source.

Claim 33 further defines the apparatus of Claim 20, wherein said apparatus further includes a means for tokenizing a title for addition into said grammar.

Claim 34 further defines the apparatus of 20, wherein said apparatus includes a means for dynamically adding said grammar to a speech recognizer.

Applicants respectfully point out that the Examiner has not complied with relevant law in setting forth her rejection of Claims 30-34. More specifically, "all words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). The Examiner has NOT addressed any of the above high-lighted terms of Claims 30-34 in her rejection. As such, the rejection of Claims 30-34 under 35 U.S.C. 103(a) is improper and should be withdrawn.

Even if the Examiner had addressed all of the words of each of Claims 30-34, the Examiner has not set forth a *prima facie* case of obviousness of Claims 30-34. In proceedings before the Patent and Trademark Office, “**the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art**”. In re Fritch, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (citing In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). “**The Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references**”, In re Fritch, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992)(citing In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988)(citing In re Lalu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)).

Independent Claim 20 (from which Claim 30-34 depend directly or indirectly) requires and positively recites, an apparatus, comprising: “**a speech user agent that dynamically creates vocabulary, grammar and actions**” and “**a browsing module for the world wide web being responsive to said speech user agent, said speech user agent facilitating voice activation of said browsing module to access an information resource on the world wide web**”.

The Examiner admits that Stefanopoulos et al, does not teach a speech user agent. The Examiner instead relies upon Schmandt for such teaching. The Examiner's determination to combine Stefanopoulos and Schmandt is flawed for several reasons. First, while Schmandt discloses speech or voice to navigate in a windows environment, there is no evidence in the record that supports a determination that Schmandt's speech or voice is equivalent to Appellants' “speech user agent”. Seeming to confirm the above, the Examiner even fails to make any specific argument that Schmandt's speech or voice is equivalent to Appellants' “speech user agent”. Second, even were Schmandt to disclose a “speech user agent”, it fails to teach or suggest, “**a speech user agent that dynamically creates vocabulary, grammar and actions**”, as required by Claim 20.

Applicants further submit that the Examiner's motivation to combine Stefanopoulos and Schmandt is fatally flawed for up to four reasons. First, Schmandt's "use of speech or voice to navigate in a windows environment" is not designed for use on the "Web" - it was designed to navigate a windows environment on an X windows server. Second, such access would not be "easy" since all of the locations would have to have been pre-identified and entered into a computer by the user implementing Schmandt's computer and voice templates would have to have been previously enrolled for the specific location(s) - which is not "easy". Third, Schmandt's "use of speech or voice to navigate in a windows environment" does NOT reduce manual, intervention [i.e., the use of keyboard], as previously suggested by the Examiner. Fourth, there is no teaching or suggestion in Schmandt that would lead one of ordinary skill in the art at the time of the invention to make the determination that Schmandt's speech interface is "user friendly".

As a result, the Examiner reliance on a combination of Stefanopoulos and Schmandt as teaching "a speech user agent **that dynamically creates vocabulary, grammar and actions**", as required by Claim 20 (from which Claim 30-34 depend directly or indirectly) is improper and itself should itself be sufficient evidence that the Examiner has failed to provide a *prima facie* case of obviousness.

In addition to the above, dependent Claims 30-34 add additional elements not found in base claim 20. The Examiner admits that Stephanopoulos et al., in view of Schmandt, "... do not ... teach dynamically adding grammar to a speech recognizer (as further required by Claim 34), extracting a grammar from a hypermedia source (as further required by Claim 31), automatically producing an intelligent grammar from said information source (as further required by Claim 30), processing said grammar to produce a reference to said hypermedia source (as further required by Claim 32), and tokenizing a title for addition into said grammar (as further required by Claim 33) (Office Action of 06/04/2004, page 6, lines 5-9).

The Examiner argues that the additional above recited elements of Claims 30-34 are taught by Arons (abstract, section “Plans for future versions”, section “Software version”, and “The links”) (Office Action of 06/04/2004, page 6, lines 13-14). The Examiner provides no additional specific page and/or paragraph locations of teaching for the above additional elements in Arons.

Which of claims is the abstract relevant to? Where is the specific teaching of the claim in Arons? Which of Claims 30-34 is the “Plans for future versions” relevant to? Where is the specific teaching of the claim in Arons? Which of Claims 30-34 is the “Software version” relevant to? Where is the specific teaching of the claim in Arons? Which of Claims 30-34 is the “The links” relevant to? Where is the specific teaching of the claim in Arons? Applicants respectfully respond that it is the Examiner’s burden to provide evidence that Claims 30-34 are not patentable – it is NOT Applicants burden to provide evidence that Claims 30-34 are patentable. Since the Examiner does not identify which of the above sections is applicable to which claim and further does not identify the specific location of evidence in Arons supporting the Examiner’s argument, no *prima facie* case of obviousness for the additional elements of Claims 30-34 has been established and the rejection should be withdrawn.

Accordingly, the Examiner has failed to provide any evidence from the prior art that supports motivation to one having ordinary skill in the art to combine Arons with Stefanopoulos and Schmandt. As such, the 35 U.S.C. 103 rejection of Claims 30-34 is improper and should be withdrawn.

4) The Examiner rejects newly added claims 37-48 as being similar in scope and content of claims rejected above and are rejected under similar rationale. Applicants respectfully traverse this rejection as set forth below.

Independent Claim 37 requires and positively recites, an apparatus, comprising: “a speech user agent that dynamically creates vocabulary and grammar” and “a browsing module for the world wide web being responsive to said speech user agent, said speech user agent facilitating voice activation of said browsing module to access an information resource on the world wide web”.

Independent Claim 38 requires and positively recites, an apparatus, comprising: “a speech user agent for accessing a browsing module for the world wide web, said speech user agent dynamically creates vocabulary and grammar for a user to use in a given situation to enable said browsing module to access an information resource on the world wide web”.

Independent Claim 39 requires and positively recites, an apparatus, comprising: “a speech user agent enabled to access a speakable Hotlist” and “a browsing module for the world wide web being responsive to said speech user agent, said speech user agent facilitating voice activation of said browsing module to access an information resource on the world wide web”.

Claim 40 further defines the apparatus of Claim 39, wherein said speakable Hotlist comprises grammars associated with respective URLs.

Claim 41 further defines the apparatus of Claim 39, wherein said speakable Hotlist is modifiable by voice command.

Claim 42 further defines the apparatus of Claim 41, wherein the voice command is a phrase that adds a page to the Hotlist.

Claim 43 further defines the apparatus of Claim 42, wherein adding a page to the Hotlist comprises adding the title of the page as a default grammar and associating that grammar with a current URL.

Independent Claim 44 requires and positively recites, an apparatus, comprising: “a speech user agent enabled to use phonetic models to allow recognition of a vocabulary word without training on that specific word and enabled to dynamically modify grammars particular to a Web page”.

Claim 45 further defines the apparatus of Claim 44, wherein said speech user agent supports at least one of the group of: speakable Hotlist, speakable links, and smart pages in the speech user agent.

Claim 46 further defines the apparatus of Claim 45, wherein said links are Hyperlinks.

Independent Claim 47 further defines a method of extracting link names from a page of a speakable Hotlist, comprising the steps of: “speaking a link name”, “retrieving the link name from the page”, “identifying token(s) in the link name”, “creating pronunciation grammar(s) for the token(s)”, “creating grammars for the link token(s)”, “creating a grammar for all the links on the page” and “adding the created grammars to the current set known by a speech recognizer”.

Claim 48 further defines the method of Claim 47, wherein said link name is a link name/URL pair.

The Examiner in the Office Action of June 4, 2004 and again in the Office Action of March 11, 2005, provides one 35 U.S.C. 103 rejection against Claims 20, 21, 24-28, 35 and 36 and another 35 U.S.C. 103 rejection against Claims 30-34. No where in either of the Office Actions does the Examiner explain which of the above rejections is applicable to respective ones of Claims 37-48. Case law demands that, "all words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). There is no evidence in the Office Action of 06/04/2004 and again in the Office Action of March 11, 2005 that the Examiner considered any, much less all, the words of Claims 37-48. Moreover, even were the Examiner to identify which of the two 35 U.S.C. 103 rejections is

applicable to respective ones of Claims 37-48, Applicants fail to see how the rejections are related to the teaching of Claims 39-48.

Independent Claim 39 requires and positively recites, an apparatus, comprising: “a speech user agent **enabled to access a speakable Hotlist**” and “a browsing module for the world wide web being responsive to said speech user agent, said speech user agent facilitating voice activation of said browsing module to access an information resource on the world wide web”. The two previous 35 U.S.C. 103 rejections set forth by the Examiner have nothing whatsoever to do with “a speech user agent **enabled to access a speakable Hotlist**”, as required by Claim 39. As a result, the Examiner’s argument is supposition not supported by fact. Accordingly, the 35 U.S.C. 103 rejection of this claim is improper and should be withdrawn.

Claim 40 further defines the apparatus of Claim 39, wherein said speakable Hotlist comprises grammars associated with respective URLs. The two previous 35 U.S.C. 103 rejections set forth by the Examiner have nothing whatsoever to do with “a speech user agent **enabled to access a speakable Hotlist**”, as required by Claim 39, and the additional teaching that “**said speakable Hotlist comprises grammars associated with respective URLs**”, as further required by Claim 40. As a result, the Examiner’s argument is supposition not supported by fact. Accordingly, the 35 U.S.C. 103 rejection of this claim is improper and should be withdrawn.

Claim 41 further defines the apparatus of Claim 39, wherein said speakable Hotlist is modifiable by voice command. The two previous 35 U.S.C. 103 rejections set forth by the Examiner have nothing whatsoever to do with “a speech user agent **enabled to access a speakable Hotlist**”, as required by Claim 39, and the additional teaching that “**said speakable Hotlist is modifiable by voice command**”, as further required by Claim 41. As a result, the Examiner’s argument is supposition not supported by fact. Accordingly, the 35 U.S.C. 103 rejection of this claim is improper and should be withdrawn.

Claim 42 further defines the apparatus of Claim 41, wherein the voice command is a phrase that adds a page to the Hotlist. The two previous 35 U.S.C. 103 rejections set forth by the Examiner have nothing whatsoever to do with “**a speech user agent enabled to access a speakable Hotlist**”, as required by Claim 39, and the additional teaching that “**said speakable Hotlist is modifiable by voice command**”, as additionally required by Claim 41, and “**wherein the voice command is a phrase that adds a page to the Hotlist**” as further required by Claim 42. As a result, the Examiner’s argument is supposition not supported by fact. Accordingly, the 35 U.S.C. 103 rejection of this claim is improper and should be withdrawn.

Claim 43 further defines the apparatus of Claim 42, wherein adding a page to the Hotlist comprises adding the title of the page as a default grammar and associating that grammar with a current URL. The two previous 35 U.S.C. 103 rejections set forth by the Examiner have nothing whatsoever to do with “**a speech user agent enabled to access a speakable Hotlist**”, as required by Claim 39, and the additional teaching that “**said speakable Hotlist is modifiable by voice command**”, as additionally required by Claim 41, and “**wherein the voice command is a phrase that adds a page to the Hotlist**” as further required by Claim 42, and “**wherein adding a page to the Hotlist comprises adding the title of the page as a default grammar and associating that grammar with a current URL**”, as additionally required by Claim 43. As a result, the Examiner’s argument is supposition not supported by fact. Accordingly, the 35 U.S.C. 103 rejection of this claim is improper and should be withdrawn.

Independent Claim 44 requires and positively recites, an apparatus, comprising: “**a speech user agent enabled to use phonetic models to allow recognition of a vocabulary word without training on that specific word and enabled to dynamically modify grammars particular to a Web page**”. The two previous 35 U.S.C. 103 rejections set forth by the Examiner have nothing whatsoever to do with “**a speech user agent enabled to use phonetic models to allow recognition of a vocabulary word without training on that specific word and enabled to dynamically modify grammars particular to a Web page**”, as required by

Claim 45. As a result, the Examiner's argument is supposition not supported by fact. Accordingly, the 35 U.S.C. 103 rejection of this claim is improper and should be withdrawn.

Claim 45 further defines the apparatus of Claim 44, wherein said speech user agent supports at least one of the group of: speakable Hotlist, speakable links, and smart pages in the speech user agent. The two previous 35 U.S.C. 103 rejections set forth by the Examiner have nothing whatsoever to do with "**a speech user agent enabled to use phonetic models to allow recognition of a vocabulary word without training on that specific word and enabled to dynamically modify grammars particular to a Web page**", as required by Claim 44, and the additional teaching that "**said speech user agent supports at least one of the group of: speakable Hotlist, speakable links, and smart pages in the speech user agent**", as further required by Claim 45. As a result, the Examiner's argument is supposition not supported by fact. Accordingly, the 35 U.S.C. 103 rejection of this claim is improper and should be withdrawn.

Claim 46 further defines the apparatus of Claim 45, wherein said links are Hyperlinks. The two previous 35 U.S.C. 103 rejections set forth by the Examiner have nothing whatsoever to do with "**a speech user agent enabled to use phonetic models to allow recognition of a vocabulary word without training on that specific word and enabled to dynamically modify grammars particular to a Web page**", as required by Claim 44, and the additional teaching that "**said speech user agent supports at least one of the group of: speakable Hotlist, speakable links, and smart pages in the speech user agent**", as further required by Claim 45, and the additional teaching that "**said links are Hyperlinks**". As a result, the Examiner's argument is supposition not supported by fact. Accordingly, the 35 U.S.C. 103 rejection of this claim is improper and should be withdrawn.

Independent Claim 47 requires and positively recites, a method of extracting link names from a page of a speakable Hotlist, comprising the steps of: "**speaking a link name**", "**retrieving the link name from the page**", "**identifying token(s) in the link name**", "**creating pronunciation grammar(s) for the token(s)**", "**creating grammars for the link token(s)**",

“creating a grammar for all the links on the page” and “adding the created grammars to the current set known by a speech recognizer”. The two previous 35 U.S.C. 103 rejections set forth by the Examiner have nothing whatsoever to do with the above recited elements. As a result, the Examiner’s argument is supposition not supported by fact. Accordingly, the 35 U.S.C. 103 rejection of this claim is improper and should be withdrawn.

Claim 48 further defines the method of Claim 47, wherein said link name is a link name/URL pair. The two previous 35 U.S.C. 103 rejections set forth by the Examiner have nothing whatsoever to do with **“speaking a link name”**, **“retrieving the link name from the page”**, **“identifying token(s) in the link name”**, **“creating pronunciation grammar(s) for the token(s)”**, **“creating grammars for the link token(s)”**, **“creating a grammar for all the links on the page”** and **“adding the created grammars to the current set known by a speech recognizer”**, as required by Claim 47, and the additional teaching that **“said link name is a link name/URL pair”**, as further required by Claim 48. As a result, the Examiner’s argument is supposition not supported by fact. Accordingly, the 35 U.S.C. 103 rejection of this claim is improper and should be withdrawn.

Applicants again point out that, in proceedings before the Patent and Trademark Office, “the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art”. In re Fritch, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (citing In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). “The Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references”, In re Fritch, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992)(citing In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988)(citing In re Lalu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). As such, no prima facie case of obviousness has been established against the patentability of Claims 37-48. As such, Claims 37-48 stand allowable.

5) The Examiner's determination (Office Action dated March 11, 2004, page 8, lines 3-7) that one cannot show nonobviousness by attacking references individually is erroneous. Applicants respectfully point out that the references "individually" are THE PRIOR ART – NOT the combination of references cited by the Examiner. Applicants respectfully point out that they are entitled to analyze the references individually first, and then in combination to determine what is the prior art. In Graham v. John Deere Co., 148 USPQ 459 (U.S. Sup. Ct. 1966), the U.S. Supreme Court clearly and explicitly compared Scoggin's invention first to the Lohse patent individually, thereafter to the Mellon patent individually, and thereafter to the Livingstone patent individually. 148 USPQ 459, 472. **Such an individual assessment of the prior art references is considered well-settled law in view of the fact that the obviousness statute, 35 USC 103, "refers to the difference between the subject matter sought to be patented and the prior art, meaning what was known before as described in section 102".** Graham, 148 USPQ 459, 465-466 (quoting the Senate and House Reports, S. Rep. No. 1979, 82nd Cong., 2d Sess. (1952); H.R. Rep. No. 1923, 82d Cong., 2d Sess. (1952)). Thus, Graham requires that each reference be assessed individually to ascertain how it differs from the claims. This should be clear by realizing that 35 USC 103 has as its predicate 35 USC 102. If the factual inquiry of ascertaining the differences between the prior art and the claims results in a finding that there are no differences between the prior art (e.g., any single reference) and the claims, then a rejection under 35 U.S.C. 102 would be proper without any necessity of a rejection under 35 USC 103. Thus, when ascertaining differences between the prior art and the claims, each reference is to be taken individually as under 35 USC 102.

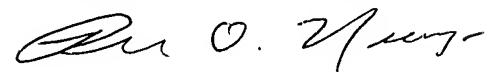
Further, Applicants' arguments do in fact consider the effect of combining the references. In re Sernaker, 217 USPQ 1 (Fed. Cir. 1983), states well the test for determining whether the ascertained differences between the prior art and the claims are such that the claimed subject matter as a whole would have been obvious: "whether a combination of the teachings of all or any of the references would have suggested (expressly or by implication) the possibility of achieving further improvement by combining such teachings along the line of the invention". Thus, the teachings of the prior art are to be evaluated as a combined whole, but after the differences between the prior art and the claims have been ascertained. Applicants' response addresses the references individually

and the purported combination. As such, Applicants response is proper. Both In re Keller, 208 USPQ2d 871, 880-881, and In re Merck & Co., 800 F.2c 1091, 231 USPQ 375 (Fed. Cir. 1986), relied on by the Examiner, assess the combined teachings of the prior art only after the differences between the prior art and claims had been determined. As such, the Examiner's determination is erroneous.

6) There is no merit to the Examiner's determination that Applicants arguments fail to comply with 37 CFR 1.111(b). The law (both statutory and case) clearly sets forth that Applicants are entitled to a patent on their invention unless the Examiner establishes a prima facie case of obviousness of the pending claims which is not refuted by Applicants. As discussed above, the Examiner has not established a prima facie case of obviousness. Having failed to establish obviousness, the Examiner now attempts to improperly shift the burden of proof to Applicants that they are entitled to a patent on their claims. The burden, however, never shifted to Applicants to prove their invention patentable over the cited art. Moreover, even if a prima facie case of obviousness had been established, Applicants' arguments above are more than sufficient to refute the Examiner's assertions and establish the patentability of the claims at issue.

Claims 20-48 stand allowable. Applicants respectfully request withdrawal of all pending rejections and allowance of the application as the earliest possible date.

Respectfully submitted,



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